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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528
22850	7590	05/16/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/941,869

**Applicant(s)**

ARNAUD, PASCAL

**Examiner**

Gina C. Yu

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on January 11, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28,31-42,44-79 and 81-102 is/are pending in the application.
- 4a) Of the above claim(s) 53-57,60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28,31-42,44-52,58,59,62-79 and 81-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

20

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2005 has been entered.

### ***Election/Restrictions***

Applicants urge to rejoin the withdrawn claims which are now amended. Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28, 31-42, 44-52, 58, 59, 83, 85, 86, 91, 96-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 52 recite “amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material”. It is not clear what this amount is. Examiner notes that specification p. 3, lines 15 – 18 states that the composition is irritating when the volatile oil is “high (typically greater than 30 %)”. On the other hand, applicants disclose in specification p. 19, bridging paragraph, that the present invention contain little or no volatile oil, in particular, less than 5 % by weight. Does 30 %, 5 %, or 0 % by weight of a volatile oil meet the claimed limitation? No specific value is given to determine the metes and bounds of the claimed limitation.

In response, applicants assert that one skilled in the art would easily be able to determine the amount by experimentation because the recited conditions of a transfer-resistant composition are well known. The argument is not persuasive because it still does not set forth a clear boundary of the scope of the claim limitation. There is nothing in the record to for a skilled artisan to readily what amount of volatile silicone oil would cause the “matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application”.

The remaining claims are rejected as they are based on indefinite base claims.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**1. Claims 1-19, 21-28, 31-42, 44, 45, 48-52, 58, 59, 62-72, 74-79, 81- 90, 92-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (US 5738841) in view of Jacks et al. (US 5690918) and Fogel (US 6126951).**

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone, 5% alkyldimethicone (silicone compounds), 12 % pigments. See examples 5 and 6; instant claims 1, 5-10, 62-69, 91-95. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The nonvolatile silicone of instant claims 28 and 79 are taught in col. 2, line 47 – col. 3, line 6. The pigments, fillers (spherical), and conventional cosmetic additives are taught in col. 3, lines 32 – 45. See instant claims 40-42, 83, 85-90. The reference teaches cyclomethicones (a volatile silicone oil) is alternatively used in place of nonvolatile oils such as polydimethylsiloxanes or phenyltrimethicones. See col. 2, lines 47 – col. 3, line 6. Application of the invention to make various formulations as claimed in instant claim 94 is taught in col. 4, lines 11 – 16.

Mellul fails to teach dispersant agent. While the reference generally teaches using fillers in the invention, the reference fails to teach the amount of fillers (inert particulate) used in lipstick composition. See instant claim 52.

Jacks teaches a lipstick composition comprising a non-volatile hydrocarbon oil (isononyl isononanoate, MW 284.48 g/mole); 1.5 % of a non-volatile silicone polymer (stearyl dimethicone); 1.9 % of mica and acrylate copolymer (particulate); dyestuff 10 % by weight (Red and Red 6); 10.34 % of diisoarachidyl dilinoleate (dispersant); and

Art Unit: 1617

paraffin. See Example 2; instant claims 1-9, 11-19, 21-23, 52, 70-72, 74-76. The reference teaches that non-volatile silicone polymer is used in the amount ranging from 0.5-16 % by weight. See col. 4, line 40 – col. 5, line 28. While the formulation contains 34.50 % cyclomethicone by weight in the formulation, the reference in general teaches that the total amount of volatile solvent for the invention is in the range of 1-68 % by weight. See col. 4, lines 8 – 39. As for claim 4, the reference teaches cetyl alcohol and isocetyl alcohol which has molecular weight of 242.44 g/mol.

Mullel and Jacks fail to teach motivation to use volatile oil in “amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material.

Fogel teaches that it is well known in cosmetic art that the use of cyclomethicones or cyclic silicones, although widely used for delivery vehicle for dermatological composition, have been under scrutiny for safety concerns and “untoward” effects. See col. 1, lines 22 – 30; col. 2, lines 31 – 45; col. 3, lines 37 – 57.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Mellul composition by adding fillers as motivated by Jacks because the Mellul teaches using fillers and Jacks illustrates a lipstick formulation comprising particular phase. The skilled artisan would have been motivated to lower the amount of cyclomethicone or not using cyclomethicone as

motivated by Fogel because of the concerns of safety and undesirable effects associated with cyclomethicones.

**2. Claims 20 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul and Fogel as applied to claims 1-19, 21-28, 31-42, 44, 45, 48-52, 58, 59, 62-72, 74-79, 81- 90, 92-99 as above, and further in view of JP 63119412.**

Mellul and Fogel, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition with improved luster and good dispersion of color, as taught by the Japanese abstract.

**3. Claims 1, 5-10, 31-35, 37-42, 44-52, 58, 59, 62, 63, 65-70, 81-83, 85-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima (EP 0548694 A1) in view of Mellul.**

Nojima teaches long-lasting, oil-based solid cosmetic compositions comprising one or more polyoxyalkylene modified silicones and one or more conventional cosmetically acceptable oils, pigments, and fillers. See abstract; Tables. The reference teaches that incorporation of a volatile oil to a cosmetic composition reduces glossy appearance and stability of the composition. See p. 2, lines 10 – 22. See p. 4, lines 45 – 47 and lines 52 – 54 for the types of fillers and the amount used. See instant claims 41, 42-45. The reference further teaches that the long wear of the composition results due to the increase in viscosity of polyether modified silicone in the composition upon the application on the skin, which holds the pigments more securely. See p. 5, lines 10 – 17. Thus it is inferred that no volatile oils are used in the Nojima transfer-resistant composition. Example 1 teaches a lipstick composition.

While Nojima generally teaches using hydrocarbon oils, the prior art does not limit the specific molecular weight range of the oils as claimed by applicants.

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone, 5% alkyldimethicone (silicone compounds), 12 % pigments. See examples 5 and 6; instant claims 1, 5-10, 62-69, 91-95. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The reference teaches that octyldodecyl neopentanoate is “an excellent agent for



Art Unit: 1617

compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it".

See col. 2, lines 11 – 21. The reference further teaches that the ester has dispersant properties with respect to powders. (to have homogenous dispersions).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Nojima by substituting the hydrocarbon oil in the formula with octyldodecyl neopentanoate as motivated by Mellul because the latter teaches that the ester is comparable with silicone, has good thermal and chemical stability, provides homogenous dispersion of pigments, and oily texture on application. The skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick composition because Nojima teaches to use hydrocarbon oil.

### ***Response to Arguments***

Applicant's arguments filed January 11, 2005 have been fully considered but they are moot in view of the new grounds of rejection.

### ***Conclusion***


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER